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REMARKS

Claims 1-8 are currently pending in the subject application and are presently under consideration. Claim 1 has been amended and new claims 32-43 have been added. In addition, the specification has been amended. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1 and 4-8 Under 35 U.S.C. §112

Claims 1 and 4-8 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner contends that there is insufficient antecedent basis for the limitation of claim 1 "A system that facilitates generating lists." (See Office Action dated May 17, 2005 at p. 2). Applicants' representative respectfully disagrees, but in order to expedite allowance of the subject claims, claim 1 has been amended to recite the limitation a system that facilitates generating one or more lists.

II. Rejection of Claims 1 and 4-8 Under 35 U.S.C. §101

Claims 1 and 4-8 stand rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Withdrawal of this rejection is respectfully requested for at least the following reasons. The claimed subject matter generates one or more lists, which is a *useful, concrete and tangible result*.

A. Supreme Court and Federal Circuit Decisions Interpreting 35 U.S.C. §101

Patentable subject matter is defined by 35 U.S.C. §101, which reads as follows:

[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

(35 U.S.C.A. §101 (West 2004)). The Supreme Court has interpreted the legislative history of 35 U.S.C. §101 as indicating that Congress intended "anything under the sun that is made by

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man" to be patentable subject matter. (*Diamond v. Chakrabarty*, 447 U.S. 303, 309, 206 U.S.P.Q. 193, 197 (1980)). The Supreme Court has held that laws of nature, natural phenomena, and abstract ideas are unpatentable. (See *Diamond v. Diehr*, 450 U.S. 175, 185, 209 U.S.P.Q. 1, 7 (1981)). The Supreme Court and the Federal Circuit both have made it clear that "it is improper to read limitations into 101 on the subject matter that may be patented where the legislative history indicates that Congress clearly did not intend such limitations." (*State Street Bank & Trust Co., v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373, 47 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1998), cert. denied 525 U.S. 1093 (1999); see also *Chakrabarty*, 447 U.S. at 308, 206 U.S.P.Q. at 196).

To determine whether subject matter is patentable, the Federal Circuit has adopted the test articulated in its *en banc* decision *In re Alappat*, 33 F.3d 1526, 31 U.S.P.Q.2d 1545 (Fed. Cir. 1994) (*en banc*) – whether the claimed subject matter as a *whole* achieves a *useful, concrete and tangible result*. (See *In re Alappat* 33 F.3d at 1544, 31 U.S.P.Q.2d at 1557; see also *State Street*, 149 F.3d at 1373, 47 U.S.P.Q.2d at 1601; and *AT&T*, 172 F.3d at 1359-61, 50 U.S.P.Q.2d at 1453-54). The *Alappat* test is founded in the Supreme Court's ruling in *Diehr*. (See *In re Alappat*, 33 F.3d at 1543-45, 31 U.S.P.Q.2d at 1556-58; see also *State Street*, 149 F.3d at 1373-74, 47 U.S.P.Q.2d at 1600-02; and *AT&T*, 172 F.3d at 1356-58, 50 U.S.P.Q.2d at 1450-52). Regarding inventions that include mathematical algorithms, the Federal Circuit has characterized the *Alappat* inquiry as:

simply requir[ing] an examination of the contested claims to see if the claimed subject matter *as a whole* is a disembodied mathematical concept representing nothing more than a "law of nature" or an "abstract idea," or if the mathematical concept has been reduced to some practical application rendering it "*useful*."

(*AT&T*, 172 F.3d at 1357, 50 U.S.P.Q.2d at 1451) (emphasis added). Thus, after the Supreme Court's rulings in *Diehr* and the Federal Circuit's rulings in *Alappat*, *State Street*, and *AT&T*, the proper test to be applied to determine patentable subject matter is whether the subject matter as a *whole* produces a *useful, concrete and tangible result*. (See *In re Alappat*, 33 F.3d at 1543-45, 31 U.S.P.Q.2d at 1556-58; see also *State Street*, 149 F.3d at 1373-74, 47 U.S.P.Q.2d at 1600-02; and *AT&T*, 172 F.3d at 1357-38, 50 U.S.P.Q.2d at 1450-52).

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Moreover, in a recent case, the Federal Circuit stated the following with regard to the patentability of computer software:

section 101 explains that an invention includes "any new and useful process, machine, manufacture or composition of matter." *Without question, software code alone qualifies as an invention eligible for patenting under these categories, at least as processes.* The patented invention in this case is such a software product. Thus, this software code claimed in conjunction with a physical structure, such as a disk, fits within *at least those two categories* of subject matter within the broad statutory label of "patented invention."

(*Eolas Technologies, Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1339, 73 U.S.P.Q.2d 1782 (Fed. Cir. 2005)) (emphasis added) (internal citations omitted). The Federal Circuit has reaffirmed its holding in *Eolas* that software alone is patentable subject matter. (See *AT&T Co. v. Microsoft*, No. 04-1285, slip op. at pp. 3-4 (Fed. Cir. July 13, 2005) available online at the Court of Appeals for the Federal Circuit web site <http://www.fedcir.gov/opinions/04-1285.pdf>).

B. The Claimed Subject Matter Produces a Useful, Concrete and Tangible Result and is Patentable

The Examiner contends that the subject claims are unpatentable because "the use of a computer is not evident in the claim." (See Office Action dated May 17, 2005 at p. 3.). To support the rejection under 35 U.S.C. §101, the Examiner cites to MPEP § 2106. (See Office Action at pp. 2-3.). Applicants' representative respectfully notes that the MPEP does not carry the force of law and that the Federal Circuit cases cited *supra* leave no doubt that software alone is patentable as a process. The proper test for determining statutory subject matter is whether the subject matter as a whole produces a useful, concrete and tangible result. The systems and methods recited in the subject claims generate a list, which is a useful, concrete and tangible result. In view of at least the foregoing, it is readily apparent that the subject claims are directed toward statutory subject matter, and, thus, this rejection should be withdrawn.

III. Rejection of Claims 1-8 Under 35 U.S.C. §102(e)

Claims 1-8 stand rejected under 35 U.S.C. §102(e) as being anticipated by Ward, U.S. Patent Number 6,526,411 ("Ward"). Withdrawal of this rejection is requested for at least the

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following reasons. Ward does not disclose each and every limitation of the claims.

A single prior art reference anticipates a patent claim only if it expressly or inherently describes *each and every limitation* set forth in the patent claim. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The *identical invention must be shown in as complete detail as is contained in the ... claim*. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Ward discloses a technique that employs metadata and usage patterns to generate a playlist. (See Ward at col. 2, lines 22-24). To identify songs for potential placement on the playlist, a database of known content is queried to return those database items having metadata that fits within a particular meta category. (See Ward at col. 2, lines 27-33 and col. 3, lines -4). The playlist then may be filtered based on usage patterns. (See Ward at col. 2, lines 33-37' col. 3, lines 5-6; and col. 5, lines 36-41). The process is repeated for each meta category until all meta categories have been searched. (See Ward at col. 2, lines 37-40).

Claim 1 recites the limitation wherein the analysis is facilitated by *a similarity subsystem designed at least in part by a machine learning technique that learns from descriptive metadata associated with a training set of items*. New claims 32-43 recite similar limitations. Ward does not disclose this novel aspect of the subject claims. For at least the foregoing reasons, applicants' representative respectfully requests that this rejection be withdrawn and that the subject claims be allowed.

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CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP241US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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